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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,941

12/08/2005

Luca Freudiger

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EXAMINER

AMADIZ, RODNEY

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/559,941	Applicant(s) FREUDIGER, LUCA	
	Examiner RODNEY AMADIZ	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/8/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

2. Claim 1 is objected to because of the following informalities: Line 4, please delete the second "at". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Berkson et al. (U.S. Patent 5,627,348--hereinafter "Berkson").

As to **Claim 1**, Berkson teaches Pen (1) (**Fig. 1**) suitable for writing and/or typing on screens and/or keyboards of electronic equipment such as computers, personal organizers, palmtops, telephones or the like (**Col. 4, lines 63-67**), comprising an elongated stem (2) (**Fig. 1, 10**) provided at least one end (2e) with a coaxial cavity (3) (**See cavity in Fig. 2**) able to house and retain inside it a rounded tip (4) (**Fig. 2, 14**),

characterized in that this tip (4) is made of a material chosen from a group comprising synthetic or natural hard stones and ceramic materials (**Col. 14, lines 53-60**).

As to **Claim 2**, Berkson teaches that the said tip (4) is made of monocrystalline synthetic ruby (**Col. 7, lines 4-9**).

As to **Claim 4**, Berkson teaches that said tip (4) is made of ceramic material (**Col. 14, lines 53-60**).

As to **Claim 6**, Berkson teaches that the said tip has the shape of a sphere (**Fig. 2, 14**) and is housed inside a cylindrical cavity which is tapered outwards and able to retain said tip inside it and is coaxially formed in one end of the said stem (**See Figs. 1 and 2**).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berkson in view of Baldwin (U.S. Patent 4,883,926—hereinafter “Baldwin”).

As to **Claim 3**, Berkson teaches that the tip is made of semi-precious stone (**Col. 14, lines 53-60**). However, Berkson fails to teach that the said tip is specifically made of monocrystalline synthetic sapphire. Examiner cites Baldwin to teach a stylus (**Fig. 1**), wherein the tip is made of monocrystalline synthetic sapphire (**Col. 3, line 62—Col. 4,**

line 6). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to replace the tip taught by Berkson with a monocrystalline synthetic sapphire as taught by Baldwin in order to provide good wear characteristics (**Baldwin—Col. 3, line 62--Col. 4, line 6**).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berkson in view of Someya et al. (U.S. Patent 5,290,972—hereinafter “Someya”).

As to **Claim 5**, Berkson teaches that said elongated stem (2) (**Fig. 1, 10**) terminates at one end in a portion in which a cylindrical seat (3) is formed, said seat being tapered outwards (**See Figs. 1 and 2**) and able to house inside it the said tip (4) (**14**) and at least the end (4f) of which projecting from the said cavity is spherically rounded (**See Fig. 2, 14**). Berkson fails to teach that the tip is shaped as a cylinder. Examiner cites Someya to teach a stylus wherein the tip is shaped as a cylinder (**See Fig. 1**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to shape the tip of a stylus into a cylinder as taught by Someya in the stylus taught by Berkson in order to provide the user with a different feel.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RODNEY AMADIZ whose telephone number is (571)272-7762. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571) 272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sumati Lefkowitz/
Supervisory Patent Examiner, Art Unit 2629

/R. A./
Examiner, Art Unit 2629
3/24/08